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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MUETING, RAASCH & GEBHARDT, P.A.  
P.O. BOX 581415  
MINNEAPOLIS, MN 55458

EXAMINER

HUI, SAN MING R

ART UNIT PAPER NUMBER

1617

DATE MAILED: 08/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/438,206

Applicant(s)

SHI ET AL.

Examiner

San-ming Hui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_                      6) ☐ Other:

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 23, 2002 has been entered.

The amendments of claims 22 and 38 filed May 23, 2002 is acknowledged.

Since the amendments after Final rejection, filed February 22, 2002, was not entered, claims 22 to 43 are still pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 30-37 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treatment employing the synergistic combination of polyethylene glycol (PEG) and 4-aminopyridine (4-AP), does not reasonably provide enablement for combination of C<sub>3</sub>-C<sub>10</sub> polyalkylene glycols and other potassium channel blockers.

In the instant case, the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention

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commensurate in scope with these claims. The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence of absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art
- 7) the predictability of the art, and
- 8) the breadth of the claims.

Applicant fails to set forth the criteria that define the useful combination of "C<sub>3</sub>-C<sub>10</sub> polyalkylene glycols" and "potassium channel blockers". Additionally, Applicant fails to provide information allowing the skilled artisan to ascertain these compounds without undue experimentation. In the instant case, the only example set forth is the synergistic combination of "PEG and 4-AP", thereby failing to provide sufficient working examples. It is noted that these examples are neither exhaustive, nor define the combination of compounds required. Synergistic effect is unpredictable, requiring each embodiment to be individually assessed for physiological activity. The instant claims read on all

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"potassium channel blockers", necessitating an exhaustive search for the embodiments suitable to practice the claimed invention. Applicants fail to provide information sufficient to practice the claimed invention, absent undue experimentation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "a compound action potential" in claim 22, lines 5 and claim 38, line 5 renders the claims indefinite as to what action potential is encompassed by the claims.

The recitation "said method resulting in a synergistic increase... behavior in said patient." in claim 30, lines 4-6 renders the claims indefinite as to method steps required to achieve the recited results.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 24-29, 38-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al. (Journal of Spinal Disorders, 1990;3(4):299-306).

Davis et al. teaches that Depo-Medrol, a depot formulation of methylprednisolone containing PEG 3350 (the product information of Depo-Medrol from PDR, 1996, page 2600-2602 is also provided), is instilled to patients having an exposed nerve root during a spinal lumbar surgery for disc excision and retraction of the nerve root with incision (See particularly the abstract). Davis et al. further teaches this procedure leads to a condition of reduced pain and spasm (See the abstract; and page 300, col. 2, last paragraph), which indicates that the patients' behavioral and neural functions are restored. Davis et al. also teaches Ciembroniewicz applying Depo-Medrol epidurally to patients at lumbar surgery for disc excision (See page 300, col. 1, third paragraph). The claims now recite the limitations of "a method of treating a patient suffered a spinal cord injury with C<sub>1</sub>-C<sub>10</sub> polyalkylene glycol".

Applicants' attention is directed to *Ex parte Novitski*, 26 USPQ2d 1389 (BOPA 1993) illustrating anticipation resulting from inherent use, absent a *haec verba* recitation for such utility. In the instant application, as in *Ex parte Novitski*, supra, the claims are directed to treating a mammalian patient suffered an injury to its spinal cord with polyethylene glycol. It is now well-settled law that administering compounds inherently possessing a protective utility anticipates claims directed to such protective use. Arguments that such protective use is not set forth *haec verba* are not probative. Prior use for the same utility clearly anticipates such utility, absent limitations distancing the proffered claims from the inherent anticipated use. Attempts to distance claims from anticipated utilities with specification limitations will not be successful. At page 1391, *Ex parte Novitski*, supra, the Board said "We are mindful that, during the patent

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examination, pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). As often stated by the CCPA, "we will not read into claims in pending applications limitations from the specification." *In re Winkhaus*, 52 F.2d 637, 188 USPQ 219 (CCPA 1975)". In the instant application, Applicants' failure to distance the proffered claims from the anticipated prophylactic utility, renders such claims anticipated by the prior inherent use.

**Response to the arguments directed to rejections under 35 USC 102(b)**

Applicant's rebuttal arguments filed May 23, 2002 averring the amended claims are now directed to the administration of polyalkylene glycol after the injury occurs, have been considered, but are not found persuasive. Injury to the spinal cord can be in the form of a contusion or compression of the spinal cord (See instant specification, page 14, lines 21-24). Patients undergoing disc excision surgery would have, at least, a slight contusion or compression to their spinal cord; or alternatively, patients with disc herniation, needing disc excision, because their spinal cord is compressed. Depo-Medrol, a PEG containing composition, was administered epidurally to the patient, after the traumatic event, i.e., the moment of the disc being excised (but still during the surgery), to reduce the pain and spasm.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 30-37, and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (Journal of Spinal Disorders, 1990;3(4):299-306) in view of Potter et al. (Clin Invest Med, 19(4), Suppl.: S80, #533), references of record in the previous office action mailed November 23, 2001.

Davis et al. teaches that Depo-Medrol, a depot formulation of methylprednisolone containing PEG 3350 (the product information of Depo-Medrol from PDR, 1996, page 2600-2602 is also provided), is instilled into patients having an exposed nerve root during a spinal lumbar surgery for disc excision and retraction of the nerve root with incision (See particularly the abstract). Davis et al. further teaches that the procedure leads to a condition of reduced pain and spasm (See the abstract; and page 300, col. 2, last paragraph), which indicates that the patients' behavioral and neural functions are restored. Davis et al. also teaches Ciembroniewicz applying Depo-Medrol epidurally to patients at lumbar surgery for disc excision (See page 300, col. 1, third paragraph). The claims now recite the limitations of "a method of treating a patient suffered a spinal cord injury with C<sub>1</sub>-C<sub>10</sub> polyalkylene glycol".

Davis et al. does not expressly teach 4-aminopyridine, the potassium channel blocker, can be combined with method of Davis et al. to treat patients with spinal cord injury. Davis et al. does not expressly teach that the spinal cord is crushed or severed.

However, Potter et al. teaches the use of 4-aminopyridine to treat spinal cord injury (See #533).



It would have been obvious to one skill in the art when the invention was made to employ a combination of 4-aminopyridine with polyethylene glycols to treat mammalian patients with spinal cord injury, including crushing or severing injury.

One of ordinary skill in the art would have motivated to employ a combination of 4-aminopyridine with polyethylene glycols to treat mammalian patients with spinal cord injury including crushing or severing injuries, because combining two agents which are known to be useful to treat spinal cord injury individually into a single method that is useful for the very same purpose is *prima facie* obvious. See *In re Kerkhoven* 205 USPQ 1069. At least additive therapeutic effects are reasonably expected. Furthermore, treating a patient who has a severed or crushed spinal cord with Depo-Medrol would have been reasonably expected to be useful because Depo-Medrol is known to reduce pain and spasm in patients with spinal cord injury.

### ***Response to Arguments***

Applicant's arguments filed May 23, 2002 averring the cited prior art's failure to provide a motivation or reasonable expectation of success, to employ PEG and 4-aminopyridine in a method to treat a patient with spinal cord injuries have been fully considered but they are not persuasive. Both agents are known to be useful in treat a patient with spinal cord injury: Depo-Medrol, a PEG containing composition, is known to reduce pain and spasm in patients with spinal cord injury and 4-aminopyridine, a potassium channel blocker, is known in the art to treat spinal cord injury. Possessing the teachings of the cited prior art, one of ordinary skill in the art would employ these agents concomitantly to treat patients with spinal cord injury since combining agents,

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which are known to treat patients with spinal cord injury individually, into a single method useful for the very same purpose is *prima facie* obvious (See *In re Kerkhoven* 205 USPQ 1069).

Applicant's arguments with respect to Brown reference have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell Travers, J.D., can be reached on (703) 308-4603. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

San-ming Hui  
August 9, 2002

RUSSELL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200